

Docket No.: NEB-165-PUS

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Raleigh, et al. EXAMINER: A. Chakrabarti

SERIAL NO.: 09/701,626 GROUP: 1655

FILED: December 1, 2000

FOR: Restriction Enzyme Gene Discovery Method

The Honorable Commissioner of  
Patents And Trademarks  
Washington, DC 20231

Sir:

**RESTRICTION REQUIREMENT**

In response to the Restriction Requirement dated August 15, 2001, in which a restriction requirement under 35 U.S.C. §§121 and 372, Applicants hereby provisionally elect Group I, claims 1-14 and 17, drawn to a method of cloning diversity-selected genes, with traverse. With respect to the request that Applicants elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable, with respect to claims 7-9, 11-14 and 16, Applicants elect SEQ ID NO:11. With respect to claims 10 and 15 by the nature of the claimed invention, two species are required. Accordingly, Applicants elect SEQ ID NO:84 and SEQ ID NO:85.

Respectfully submitted,

NEW ENGLAND BIOLABS, INC.

Dated: 9/21/01

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(Reg. No. 30901)  
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32 Tozer Road  
Beverly, Massachusetts 01915  
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## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
 Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,626	12/01/2000	Elisabeth A. Raleigh	NEB-165-PUS	8938

7590                    04/11/2002

Gregory D Williams  
 General Counsel  
 New England Biolabs Inc  
 32 Tozer Road  
 Beverly, MA 01915

[REDACTED]  
 EXAMINER

CHAKRABARTI, ARUN K

[REDACTED]  
 ART UNIT              PAPER NUMBER

1634

DATE MAILED: 04/11/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Notice of Abandonment</b>	Application No. 09/701,626 Examiner Arun Chakrabarti	Applicant(s) RALEIGH ET AL. Art Unit 1634
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1.  Applicant's failure to timely file a proper reply to the Office letter mailed on 15 August 2001.
  - (a)  A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b)  A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c)  A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d)  No reply has been received.
2.  Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a)  The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b)  The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c)  The issue fee and publication fee, if applicable, has not been received.
3.  Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a)  Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b)  No corrected drawings have been received.
4.  The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5.  The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6.  The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7.  The reason(s) below:

*Chantae Dessa*  
CHANTAE DESSAU  
PATENT ANALYST  
*for* Arun Chakrabarti  
Examiner  
Art Unit: 1634

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

NEB-165-PUS

Gene Discovery

The dating stamp of the Patent & Trademark Office  
hereon will be taken as the date of filing of:

Amendment Transmittal  
Restriction Requirement  
Check for \$55  
(Elected Group I, claims 1-14 and 17)

MAILED: 9/21/01

## Serial No.

09/701,626

## Filing Date

December 1, 2000

## Due Date

October 15, 2001

NEB-165-PUS

Gene Discovery

The dating stamp of the Patent & Trademark Office  
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Amendment Transmittal  
Restriction Requirement  
Check for \$55  
(Elected Group I, claims 1-14 and 17)

MAILED: 9/21/01

## Serial No.

09/701,626

## Filing Date

December 1, 2000

## Due Date

October 15, 2001

## NEW ENGLAND BIOLABS, INC.

**045601**

Check  
Date: 09/21/2001  
Num : 045601

INVOICE NO.	DATE	DESCRIPTION	PAID AMOUNT	DISCOUNT	APPLIED AMOUNT
0922101	09/21/2001	Vchr: V010303 10/21/2001	\$55.00		\$55.00

INTERNAL NO.	VENDOR	TOTALS
645	V00301	\$55.00

AN ARTIFICIAL WATERMARK IS PRESENT ON THE REVERSE SIDE

## NEW ENGLAND BIOLABS, INC.

**Fleet** **5-39**  
**32 TOZER ROAD**  
**BEVERLY, MA 01915**

DATE  
 09/21/2001

CHECK NUMBER  
 045601

AMOUNT  \$55.00

PAY  
 TO THE  
 COMMISSIONER OF PATENTS AND TRADEMARKS  
 WASHINGTON, DC 20231  
 ORDER  
 OF

NEW ENGLAND BIOLABS, INC.

AUTHORIZED SIGNATURE



FACE OF DOCUMENT IS A COLORED BACKGROUND ON WHITE PAPER

#045601:0110003901:536 746 781#

Practitioner's Docket No. NEB-165-PUS**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Raleigh, et al.

Application No.: 0 9 / 701,626 Group No.: 1655  
Filed: December 1, 2000 Examiner: A. Chakrabarti  
For: Restriction Enzyme Gene Discovery MethodAssistant Commissioner for Patents  
Washington, D.C. 20231**AMENDMENT TRANSMITTAL**

1. Transmitted herewith is an amendment for this application.

**STATUS**

2. Applicant is

- a small entity. A statement:  
 is attached.  
 was already filed. asserted  
 other than a small entity.

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**CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))**

I hereby certify that this correspondence is, on the date shown below, being:

**MAILING**

deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: 9/21/01**FACSIMILE**

transmitted by facsimile to the Patent and Trademark Office.



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Signature  
Melissa A. Jackson

(type or print name of person certifying)

(Amendment Transmittal [9-19]—page 1 of 4)

### EXTENSION OF TERM

**NOTE:** "Extension of Time in Patent Cases (Supplement Amendments) — If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

**NOTE:** See 37 C.F.R. § 1.645 for extensions of time in interference proceedings, and 37 C.F.R. § 1.550(c) for extensions of time in reexamination proceedings.

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

(complete (a) or (b), as applicable)

- (a)  Applicant petitions for an extension of time under 37 C.F.R. § 1.136  
(fees: 37 C.F.R. § 1.17(a)(1)-(4) for the total number of months checked below:

<u>Extension (months)</u>	<u>Fee for other than small entity</u>	<u>Fee for small entity</u>
<input checked="" type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 390.00	\$ 195.00
<input type="checkbox"/> three months	\$ 890.00	\$ 445.00
<input type="checkbox"/> four months	\$ 1,390.00	\$ 695.00

Fee: \$ 55.00

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- An extension for \_\_\_\_\_ months has already been secured. The fee paid therefor of \$\_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$\_\_\_\_\_

OR

- (b)  Applicant believes that no extension of term is required. However, this is a conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

(Amendment Transmittal [9-19]—page 2 of 4)

**FEE FOR CLAIMS**

4. The fee for claims (37 C.F.R. § 1.16(b)-(d)) has been calculated as shown below:

(Col. 1)	(Col. 2)	(Col. 3)	SMALL ENTITY	OTHER THAN A SMALL ENTITY
CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NO PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDIT. FEE OR RATE
TOTAL	MINUS ..	=	x\$9 = \$	x\$18 = \$
INDEP.	MINUS ...	=	x\$40 = \$	x\$80 = \$
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEP. CLAIM		+ \$135 = \$	+ \$270 = \$	
		TOTAL ADDIT. FEE \$	OR	TOTAL ADDIT. FEE \$

- .. If the entry in Col. 1 is less than entry in Col. 2, write "0" in Col. 3.
- .. If the "Highest No. Previously Paid for" IN THIS SPACE is less than 20, enter "20".
- ... If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".
- The "Highest No. Previously Paid For" (Total or indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

**WARNING:** "After final rejection or action (§ 1.113) amendments may be made cancelling claims or complying with any requirement of form which has been made." 37 C.F.R. § 1.116(a) (emphasis added).

(complete (c) or (d), as applicable)

(c)  No additional fee for claims is required.

OR

(d)  Total additional fee for claims required \$ \_\_\_\_\_

**FEE PAYMENT**

- Attached is a  check  money order in the amount of \$ 55.00
- Authorization is hereby made to charge the amount of \$ \_\_\_\_\_
- to Deposit Account No. \_\_\_\_\_
- to Credit card as shown on the attached credit card information authorization form PTO-2038.

**WARNING:** Credit card information should not be included on this form as it may become public.

- Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

(Amendment Transmittal [9-19]—page 3 of 4)

**FEE DEFICIENCY**

**NOTE:** If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).

6.  If any additional extension and/or fee is required, charge Account No. 14-0740

**AND/OR**

- If any additional fee for claims is required, charge Account No. 14-0740

Reg. No.: 30901

Tel. No.: (978) 927-5054 X:292

Customer No.: 28986

  
SIGNATURE OF PRACTITIONER  
Gregory D. Williams  
General Counsel(type or print name of practitioner)  
New England Biolabs, Inc.  
32 Tozer Road

P.O. Address

Beverly, MA 01915

(Amendment Transmittal [9-19]—page 4 of 4)